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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,073	10/11/2000	David Traynor	2043.165US1	5507
49845	7590	10/05/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY			COLBERT, ELLA	
P.O. BOX 2938			ART UNIT	
MINNEAPOLIS, MN 55402			PAPER NUMBER	
			3694	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,073

Applicant(s)

TRAYNOR ET AL

Examiner

Ella Colbert

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-15 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) 35-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-15 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/10/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4, 8-15, and 32-38 are pending. Claims 1-3, 8-15, and 33-34 have been amended and claims 35-38 have been added in this communication filed 07/10/06 entered as RCE.
2. The IDS submitted 7/10/06 has been considered.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/10/06 has been entered.

Election/Restrictions

4. Newly submitted claims 35-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Independent Claims 35 and 37 and dependent claims 36 and 38 generate sales information for an item with a plurality of price levels and communicate a message to a user based on the price level when the item price reaches a threshold value. The original independent claims 1, 11, and 15 are directed to a network based sales system, generating a feedback indication for an item, a plurality of price choices, and communicating the feedback indication to a user interface.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

5. Claims 1, 10, 11, 15, and 33 are objected to because of the following informalities: Claim 1, line 6 recites "choices using ... from actions of others". This line would be better recited as "choices using ... from the action of others". Claim 10 has a redundancy problem with the usage of "communicating information to display on the user interface". This claim limitation would be better recited as "The method of claim 1 wherein the communicating of the information includes displaying on the user interface a present price, at least one future price and a purchase control button next to the present price and a future purchase control button next to the at least one future price".

Claim 11, lines 4 and 5 recite "... via the network and to display information pertaining to a plurality of price choices pertaining to a selected item;". The usage of the word "pertaining" is redundant. This line would be better recited as "... via the network to display information pertaining to a plurality of price choices of a selected item;". Claim 15, line 6 recites "... generated from actions of". This line would be better recited as "generated from the actions of". Claim 33, line 4 recites "plurality of price choices includes adjusting duration ...". This line would be better recited as "plurality of price choices includes adjusting the duration ...".

Nothing in the preamble or body of the independent claims mentions "sales activity feedback" which is in the title of the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 11, and 15 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. There are steps missing from the claims which are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claim 1, the first claim limitation recites "communication via a first network information ...". "A first network information is not mentioned again in the claim limitations. Therefore, an essential step is missing. A suggestion: Communication via the first network the feedback indication for the item to the user interface using supply and sales level information generated from the actions of other users".

Claim 11, the last claim limitation recites "a feedback indication area ... within the network based sales system". There appears to be an essential step missing because there is not another claim limitation reciting "a feedback indication area" or "network based sales system" in the body of the claim.

Claim 15 recites "means for generating a feedback indication ...". After this step a suggestion is the step of: "means for communicating and generating the feedback

Art Unit: 3693

indication for the item to the user interface". These are only suggestions for the added steps in the independent claims. Applicants' may want to add different steps to the claims with similar wording. The dependent claims 2-4, 8-10, 12-14, and 32-34 are also rejected based on their dependency from a rejected base claim.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 1 recites "A method" and the body of the claim begins with system steps (e.g., communicating via a first network and a network based sales system). The claim embraces or overlaps two different statutory classes of invention. The claim limitations appear to be more those of a system claim than a method claim with steps. Example of a method claim step: communicating via a network information to a user interface, the information pertaining to a plurality of price choices for an item offered; generating a feedback indication for the item at each of the plurality of price choices using supply and sales level information generated from the actions of other users; and communicating the feedback indication to the user interface".

Claim Rejections - 35 USC § 101

10. 35 U.S.C. § 101 reads as follows:

Art Unit: 3693

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

11. Claim 1 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claim 1), the body of the claim discusses the specifics of the system of the information pertaining to a plurality of price choices, and subsequently the claim then deals with the specifics of a method (the steps) generating a feedback indication and communicating the feedback indication (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Drawings

12. The drawings are objected to because Drawing figures 1-10 have shading which needs to be removed. Figure 8, some of the element numbers are barely legible because of the dark shading. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

13. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1, reference character "22"; Figure 2, reference character "50"; and Figure 7, reference character "120". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by

Art Unit: 3693

the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

14. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figures 1 and 2, reference character "48 Odds indicators" is not found in either figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

15. The Specification is objected to because Page 12, lines 20-32 recite "In one embodiment, each time a tracked event (step 100), such as a purchase of ...". These lines would be better to begin with "Referring to Figure 6, in one embodiment, each time a tracked event (step 100), such as a purchase of ...". This would let the reader know that Figure 6 is being discussed. Page 13 recites the acronyms "DTMF" and "WML" in lines 27 and 29. Acronyms should be written for example as on page 1, line 16

(Background of the Invention) "So-called Request-for-Proposal (RFP) ...". Page 14 has a similar problem with the acronym "MSRP". Page 14 recites "Referring to Fig. 8, the system 10 ...". This line would be better recited as "Referring to Fig. 8, the system 10 (Fig.1) ...". Page 15 line 1 recites "Referring also to Fig. 9, pressing a future buy button 138 for an item can bring the user to the item pricing window 30, or it can cause a smaller item pricing window 140 to be overlaid on top of the catalog window 130. In one embodiment, the overlaid window ..., browsing. The ... navigation commands 126 in a navigation window 128,". These lines would be better recited as "Referring also to Fig. 9, pressing a future buy button 138 (Fig. 7) for an item can bring the user to the item pricing window 30 (Fig. 2), or it can cause a smaller item pricing window 140 to be overlaid on top of the catalog window 130 (Fig.8). In one embodiment, the overlaid window ..., browsing. The ... navigation commands 126 (Fig.8) in a navigation window 128 (Fig.8),". This will let the reader know which figures the reference characters are found in that are being discussed. Correction is required. See MPEP § 608.01(b).

An art rejection has not been given because of the numerous issues with the claims, drawings, and specification.

Inquiries

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

Art Unit: 3693

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 28, 2006


ELLA COLBERT
PRIMARY EXAMINER